



AF/DPW

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/801,309

Confirmation No. 1978

Applicant: William E. Italia

Filed: March 16, 2004

TC/AU: 2617

Examiner: HOLLIDAY, JAMIE MICHELE

Docket No.: 252274 (Client Reference No. GP-304136)

Customer No.: 73811

**TRANSMITTAL OF
APPELLANT'S REPLY BRIEF**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.41, appellant hereby submits Appellant's Reply Brief.

The items checked below are appropriate:

1. Status of Appellant

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Oral Hearing

☐ Appellant requests an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

☐ Appellant requested an oral hearing in accordance with 37 CFR 41.47 at the time appellant filed Appellant's Brief on Appeal.

3. Extension of Time

- ☐ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$ 0.00.
- ☒ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$ 0.00

4. Total Fee Due

The total fee due is:

Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 0.00

Total Fee Due: \$0.00

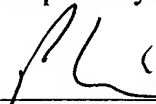
5. Fee Payment

- ☐ Attached is a check in the sum of \$
- ☐ Charge Account No. 12-1216 the sum of \$

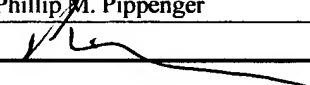
6. Fee Deficiency

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216.

Respectfully submitted,


 Phillip M. Pippenger, Reg. No. 46,055
 LEYDIG, VOIT & MAYER, LTD.
 Two Prudential Plaza
 180 North Stetson Ave., Suite 4900
 Chicago, Illinois 60601-6731
 (312) 616-5600 (telephone)
 (312) 616-5700 (facsimile)

Date: February 19, 2009

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being <input type="checkbox"/> deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number , <input checked="" type="checkbox"/> deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or <input type="checkbox"/> facsimile transmitted to the U.S. Patent and Trademark Office at fax number: (571) 273-8300.			
Name (Print/Type)	Phillip M. Pippenger		
Signature		Date	February 19, 2009



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application No. 10/801,309

Applicant: William E. Italia

Filed: March 16, 2004

TC/AU: 2617

Examiner: HOLLIDAY, JAMIE MICHELE

Docket No.: 252274 (Client Reference No. GP-304136)

Customer No.: 73811

APPELLANTS' REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer dated December 19, 2008,
Appellants now submit their Reply.

The issue here is so focused that the Examiner's lengthy response only serves to obfuscate the issue. So let's cut through the fog. The claim term in question is as follows:¹

"assigning the MDN [mobile dialing number] ... to the MCD [the mobile device]."

The Examiner correctly understands that this requires that "a number is assigned to the mobile device." See Examiner's Answer, page 12, section reproduced here:

As cited, the claim reads that a number is assigned to the mobile device
that provides a local connection.

The Examiner also correctly admits that in the prior art, the local number is assigned ONLY to a temporary data unit, NOT to the mobile device ("...assigned TLDN [temporary local dialing number] *to the data unit*..."). See copied excerpt from same page, below:

¹ This phrase has come up in prosecution as one of many obvious distinctions, but it will be appreciated that the patentability of the claims could be shown via any number of other distinctions as well –the applied art is almost entirely inappropriate with respect to most elements of most claims.

the assigned

TLDN to the data unit will be used to route the call to the mobile phone.

Thus, the parties agree that (1) the claims require a local number to be assigned *to the mobile device*, and (2) the temporary local number in the asserted prior art is assigned *not* to the mobile device but rather to an intermediary data unit.

OK, so what's the problem then? Why are we here wasting the Board's time and squandering the limited resources of American industry on what should be a non-issue? Good question. We're here because the facts don't seem to matter – the Examiner continues to assert that assigning a local number to some network relay on a temporary basis is exactly the same as assigning a local number to the mobile device itself. Really?

Do you have a cell phone? Maybe it has been assigned a local number like *571*-xxx-xxxx or *301*-xxx-xxxx? Let's now assign it a Texas number like *713*-xxx-xxxx. Is this really the same to you? Are you really indifferent about the switch? Of course not. It will now cost you a dollar every time you make what should have been a local call. It will also cost your local friends and colleagues a bundle every time they try to call you. It goes without saying that you *care* what number is assigned to your phone because it *matters*. Assigning a number to some device in the network is quite clearly *not* the same as actually changing the number of your cell phone.

In short, there is no disagreement as to what the claims require nor is there any disagreement as to what the art teaches -- *and the two do not match*. The claims are easily and clearly distinguished over the art, and should be found to be patentable. It is respectfully requested that the application be remanded with guidance to allow the claims.

Respectfully submitted,



Phillip M. Pippenger, Reg. No. 46,055
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza
180 North Stetson Ave., Suite 4900
Chicago, Illinois 60601-6731
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: February 19, 2009